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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/025,947

12/26/2001

Hsuan-Yin Lan-Hargest

12938-003002

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7590

10/10/2002

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EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 10/10/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/025,947

Applicant(s)

LAN-HARGEST ET AL.

Examiner

Paul A. Zucker

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 6, 9-11, 14, 15, 18-21, 23, 24 and 27-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 17 July 2002 in Paper No 9.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-49 remain outstanding.
4. Claims 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 are held withdrawn from consideration.
5. The objection to the specification set forth in paragraph 3 of the previous Office Action in Paper No 9 is withdrawn in response to Applicant's amendment.
6. This application contains claim 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
7. The rejection under 35 U.S.C. 102(b) as being anticipated by Patel et al (Journal of Organic Chemistry 1978, 43(26) pages 5018-5020) set forth in paragraph 4 of the previous Office Action in Paper No 9 is withdrawn in response to Applicant's amendment.

### ***Examiner's Response to Applicant's Arguments with Regard to This Rejection***

8. Applicant has argued (Amendment, page 4, 3<sup>rd</sup> full paragraph- page 5, end of 2<sup>nd</sup> full paragraph) that the group L is required to be substituted in the previous claims 1 and 22 and that, therefore, Patel does not anticipate the claims since in the 7-phenyl-2,4,6-heptatrienoic acid disclosed does not contain a substituted hydrocarbon chain.

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The Examiner disagrees and points out that the phenyl group representing the variable group A constitutes the required substitution ("monocyclic aryl") of the hydrocarbon chain.

9. The rejection under 35 U.S.C. 102(b) as being anticipated by Black et al (US 5,037,813 08-1991) set forth in paragraph 5 of the previous Office Action in Paper No 9 is withdrawn in response to Applicant's amendment.

***New Rejections***

***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 22, 25 and 26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 recites two groups (lines 13-15 and 1-19) of possible identities for the substituents of variable group L. Because there two definitions of the possible substituents, the intended group of possible indentities for the substituents of L is unclear. Claim 22 and its dependents are therefore rendered indefinite.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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11. Claims 1-5, 12, 13 and 22 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Harding et al (Journal of Organic Chemistry 1981, 46, pages 940-948). Harding discloses (Page 943, paragraph bridging the left and right columns) the synthesis of 4-phenoxyacetic acid. Harding thus anticipates instant Claims 1-5, 12, 13 and 22.

12. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25 and 26 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Broughton et al (GB 2 005 271-A 04-1979). For the purposes of this rejection the broadest group of substituents for L is assumed. Broughton discloses (Page 1, lines 59-61), for example, the following compounds, BA-BC, and their use as pesticides:

( $\mp$ )-9-hydroxy-11-phenylundec-7-*trans*-enoic acid

( $\mp$ )-9-hydroxy-10-phenoxydec-7-*trans*-enoic acid

( $\mp$ )-11-hydroxy-12-phenoxydodec-9-*trans*-enoic acid.

Broughton therefore anticipates (Page 1, lines 59-61), for example, the following compounds instant claims 1-5, 7, 8, 12, 13, 16, 17, 22 and 26.

13. Claims 1-5, 12, 13 and 22 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Gordon et al (US 5,747,537 05-1998). Gordon discloses (Column 8, lines 20-62) the synthesis of 9-phenoxyoctanoic acid. Gordon thus anticipates Claims 1-5, 12, 13 and 22.

***Conclusion***

14. Claims 1-49 are outstanding. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25 and 26 are finally rejected. Claims 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 are held finally withdrawn from consideration.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker  
Patent Examiner  
Technology Center 1600

October 9, 2002

  
Johann Richter, Ph.D., Esq.  
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